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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,708	01/05/2004	William L. Berg	B044 P00773-US1	2267
3017	7590	10/07/2005		
BARLOW, JOSEPHS & HOLMES, LTD. 101 DYER STREET 5TH FLOOR PROVIDENCE, RI 02903			EXAMINER ROYAL, PAUL	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,708

Applicant(s)

BERG, WILLIAM L.

Examiner

Paul Royal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/23/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species 1, figures 1-4 in the reply filed on 06/28/05 is acknowledged.

The traversal is on the ground(s) that the species are obvious variants of each other presented for the illustration of alternative embodiments. This is found to be persuasive and acceptable therefore the restriction requirement is hereby withdrawn.

Note, Applicant's election of species did not include a listed of the claims which applicant believes reads on the elected species.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "first and second seat" and magnets of claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the preamble introduces the storage compartment, therefore at line 5, "a storage compartment" should be "the storage compartment".

In claims 2 and 7, the claim states the storage compartment further comprises a storage compartment. The second instant of the storage compartment makes the claim appear to include either two storage compartments or a storage compartment within a storage compartment. There is no support for the storage compartment including a storage compartment.

In claim 2, the term "an interior cavity" should be "the interior cavity" because claim 1 has already introduced the interior cavity.

4. Claims 4, 5, 9, 10, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 4, 9 and 15, it is not clear what applicant considers first and second seats formed at opposing ends of the aperture. Applicant does not include these features in the drawings.

For claims 5, 10 and 16, it is not clear what applicant considers first and second magnets formed at the ends of the binder rail. Applicant does not include these features in the drawings.

For claim 20, it is not clear what applicant considers first and second seats formed at opposing ends of the aperture and what applicant considers first and second magnets formed at the ends of the binder rail.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 11, 13, 14, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abraham (US 1,068,621) in view of Bulka (US 5,454,179) and Cole (US 214,105).

Abraham teaches a storage and framing unit comprising:

a picture frame (5), said picture frame including a front surface/perimeter rail, a rear surface, the front surface/perimeter rail defining an aperture/opening (see line 70) in said front surface defining a display area, said display area configured to receive and retain a picture therein;

a storage compartment (8) having an interior cavity, said storage compartment received adjacent said rear surface of said picture frame (5); and

means (9) for attaching said storage compartment to said rear surface of said picture frame such that said storage compartment can be slideably removed from said picture frame,

the storage compartment having a rear wall and side walls extending upwardly from said rear wall, said rear wall and said side walls cooperating to define the interior cavity (see lines 73-80 where a single strip of metal is bent on three edges, the three edges are understood to form the walls and an interior of the storage compartment);

an aperture (11) in said side wall, said aperture allowing access to said interior cavity to allow a user to place objects therein; and

a closure element (13) configured to be received adjacent said aperture, wherein said closure element is a binder rail with photo storage pages (12) attached thereto, said photo storage pages extending through said aperture into said interior cavity when said closure element is installed adjacent said aperture (11).

Abraham does not teach that the storage compartment can be slideably removed from the picture frame and instead uses flanges (9) permanently secured to the rear of the frame using fastening devices (10) such as nails.

Abraham further does not teach mounting channels formed along the rear edges of the perimeter rail member, receiver channels formed long parallel edges of the side walls of the storage compartment, mounting rails fastened to the rear surface of the picture frame, nor a corresponding pair of receiver channels formed along parallel edges of the storage compartment.

Bulka teaches a display frame which includes slideably attaching a front frame member (12) to a frame backing member/storage compartment (16) where a sliding attachment (42, 52) is used in place of the screw or stapling attachment (42, 56), to display a product in an attractive manner.

Cole teaches a combined picture frame and packing box which includes mounting channels (b) formed along the rear edges of the perimeter rail member, receiver channels (b) formed long parallel edges of the side walls of the storage compartment to provide a photograph-easel and an fancy box for stationary.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the storage and framing unit of Abraham to include wherein the storage compartment can be slideably removed from the picture frame, as taught by Bulka, to display a product in an attractive manner and to further modify the storage and framing unit of Abraham to include mounting channels (b) formed along the rear edges of the perimeter rail member, receiver channels (b) formed long parallel edges of the side walls of the storage compartment, as taught by Cole, to provide a photograph-easel and an fancy box for stationary.

For claims 6-8, note Applicant has asserted the Species in Figures 1-5 are obvious variants of one another, therefore the mounting channels and receiver channels of claims 17-20, which are most clearly shown in the prior art Cole, are understood to be obvious variants of the mounting rails and receive channels of claims 1-16 and therefor Cole is applicable to claims 1-20. For example the locations of the mounting channels and the receiver channels of claims 17-20 as compared to the mounting rails and receiver channels of claims 1-16 are understood to be admittedly obvious variants where the prior art applicable to one group of claims is understood to be applicable to the corresponding element in the other group of claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cole teaches a picture frame. Shroyer teaches an aquarium/picture combination. Ferris et al. teaches a concealed compartment in a


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picture frame. Primm et al. teaches a storage and framing unit. Hensel teaches a refrigerator artwork organizer.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Royal whose telephone number is 571-272-6652. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


P. Royal
10/3/2005

Paul Royal
Examiner
Art Unit 3611


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